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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,628	12/08/2000	Kyunam Kim	M-8786 US	8874

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EXAMINER	
VU, KIEU D	

ART UNIT	PAPER NUMBER
2173	11

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/732,628	KIM, KYUNAM	
	Examiner	Art Unit	
	Kieu D Vu	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-71* is/are pending in the application.

4a) Of the above claim(s) *71* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Applicant's election of Group I, claims 1-70 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 40 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 recites the limitation " said organization ". There is insufficient antecedent basis for this limitation in the claim.

Claim 60 recites the limitation " said list ". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-20, 27, 28, 30-41, 44-58 and 61-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Megiddo (6559863) and Rodriguez (6650761)

Regarding claim 1, Megiddo teaches a method of communicating between users (col 1, lines 57-67) comprising displaying an image to a first user to represent a second user communicating with the first user by a computer and transferring a message between said first user and said second user (col 5, line 29 to col 6, line 40) (see Fig. 2a-c). Megiddo differs from the claim in that Megiddo does not teach that the use of the image is contracted through the owner of the image. However, contracting or licensing an image for use is old and well known in the art for the purpose of bringing financial reward or compensation for the owner for the use of his/her image. For example, Rodriguez teaches that images can be licensed for use in a computer (col 60, lines 14-23). Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Rodriguez's teaching of licensing an image for use in the system of Megiddo's system with the motivation being to bring financial reward or compensation for the owner for the use of his/her image.

Regarding claim 2, although Rodriguez does not teach that the image identifies a source of a product or service, it is old and well known in the art that when the image is registered as a trademark, it identifies a source of a product or service. Thus, it would have been obvious to one skilled in the art at the time the invention was made to register an image as a trademark with the motivation being to identify a source of a product or service.

Regarding claim 3, although Rodriguez does not teach that the registering an image as a trademark to identify a source of a product or service, such practice is old and well known in the art. Thus, it would have been obvious to one skilled in the art at

the time the invention was made to register an image as a trademark with the motivation being to identify a source of a product or service.

Regarding claim 4, although Rodriguez does not specify the detail of the trademark image, it is considered old and well known in the art of trademark to have a trademark that is formed by a plurality of elements that together define a trade dress of a product or service of the owner.

Regarding claim 5, although Rodriguez does not specify the detail of the trademark image, it is considered old and well known in the art of trademark to have a trademark that is a mascot of the owner.

Regarding claim 6, although Rodriguez does not specify the image is copyrighted by the owner, such practice it is considered old and well known in the art of trademark.

Regarding claim 7, Megiddo teaches that the image can be a character (see figure 2a).

Regarding claim 8, Disney is the source of dolls of its characters, e.g. Disney's dolls.

Regarding claim 9, Megiddo teaches displaying a background image also (see figure 2a).

Regarding claims 10-14, although Megiddo does not teach that the background includes a plurality of tiles and whether tiles are different or the same, such features are old and well known in the art of making a background image in computer. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use configure the background with a plurality of different tiles or identical tiles with the

motivation being to accommodate and enhance different designs for the system designers.

Regarding claim 15, although Megiddo does not teach that the background includes a trademark to identify a source of a product or service, it would have been obvious to one skilled in the art at the time the invention was made to include a trademark image in the background with the motivation being to identify a source of a product or service.

Regarding claim 16, although Megiddo does not teach that the background includes a advertisement to identify a product or service, it would have been obvious to one skilled in the art at the time the invention was made to include an advertisement in the background with the motivation being to identify a product or service.

Regarding claim 17, although Megiddo does not teach that the background includes a trade name, a trademark, trade dress or a service mark of an organization other than the owner of the image, such inclusion when desired requires only routine skill in the art. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use such trade name, a trademark, trade dress or a service mark of an organization in the background with the motivation being to indicate and identify the presence of such organization.

Regarding claim 18, see figure 2a of Megiddo for the appearance of a room in the background.

Regarding claim 19, Megiddo teaches the movement of the image affects the display of the background at the place of displacement (inherent).

Regarding claim 20, see figures 2b and 2c of Megiddo for the movement of the images.

Regarding claim 28, Megiddo shows more than three images in the chatting room. See figure 3a.

Regarding claim 30, audio communication is taught by Megiddo in col. 5, line 29 to col. 6, line 40.

Regarding claim 31, text communication in caption box is taught by Megiddo in figure 2a.

Regarding claim 32, figure 1a of Megiddo shows server 25.

Regarding claim 33, communication between the two users does not have to be broadcasted to other if not desired. In other words, communications between two users can be kept between themselves. Although Megiddo does not mention the commercialization of the image and chatting, it would have been obvious to one skilled in the art at the time the invention was made to use such image and chatting method and apparatus for the purpose of purchasing or selling a product with the motivation being to make a profit.

Regarding claim 34, Rodriguez teaches downloading the licensed image (see col. 60, lines 15-23).

Regarding claim 35, although Megiddo does not teach that image is read from a storage medium, storing image in a disk or a storage medium for computer to read is considered old and well known in the art. Thus, it would have been obvious to one skilled in the art at the time the invention was made to store images in a disk for

computer to read in Megiddo's system with the motivation being to enable to store the image in a storage medium for later use.

Regarding claim 36, although Megiddo does not mention the commercialization of the image and chatting, it would have been obvious to one skilled in the art at the time the invention was made to use such message and chatting method and apparatus for the purpose of purchasing or selling a product with the motivation being to make a profit.

Regarding claims 37-39, although Rodriguez does not specify that who can own the image to be licensed, it would have been obvious to one skilled in the art at the time the invention was made to recognize that the owner of the images could be a business organization, a church, an education institution, etc with the motivation being to sell product or services, preach or teach accordingly.

Regarding claim 40, although Rodriguez does not specify that the second users works in 24 hour shift in the organization, it would have been obvious to one skilled in the art at the time the invention was made to recognize the method can be used by any one including those who works 24 hour shift in the organization with the motivation being to provide the use of the method to those who works 24 hour shift in the organization.

Regarding claim 41, Megiddo clearly teaches that each image is associated with a user and that the image is moved in cooperation with the operation of the computer by the first user (Fig. 2a-c).

Regarding claim 44, although Megiddo does not mention the security issue of the network, it would have been obvious to one skilled in the art at the time the invention was made to use such password implementation in the system of Megiddo in view of Rodriguez with the motivation being to enhance the security and integrity of the system.

Regarding claim 45, it would have been apparent to one skilled in the art to recognize that instructions for the computer to perform the displaying and transferring of message/image can be downloaded from a distant computer into the memory for execution. The downloading requires a signal encoded in a carrier medium to contain those instructions. Thus, it would have been obvious to one skilled in the art at the time the invention was made to download instructions for the computer to perform the displaying and transferring of message/image from a distant computer into the memory for execution with the motivation being to offer convenient software installation/ upgrades without the use of physical disks.

Regarding claims 46 and 63, it is old and well known in the art that instructions for the computer to perform the displaying and transferring of message/image is usually stored in the computer hard drive and loaded into the memory for execution.

Regarding claim 47, Megiddo teaches a computer system comprising a communication network (see the Internet) and a lot of computers interconnected by the communication network having installed therein graphic chat-room software, wherein each computer displayed a plurality of image, each image represents a user. However, Megiddo does not explicitly teach that there is at least one image owned by an organization and used under contract with said organization. However, owning an

image and licensing the use of the image is old and well known in the art as evidenced by Rodriguez (col 60, lines 14-23). Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Rodriguez's teaching of licensing an image for use in the system of Megiddo's system with the motivation being to bring financial reward or compensation for the owner for the use of his/her image.

Regarding claims 48-49, although Rodriguez does not teach that the image was previously used to identify a source of a product or service, it is old and well known in the art that when the image is registered as a trademark, it identifies a source of a product or service. Thus, it would have been obvious to one skilled in the art at the time the invention was made to register an image as a trademark with the motivation being to identify a source of a product or service.

Regarding claim 50, although Rodriguez does not specify the image is copyrighted by the owner, such practice it is considered old and well known in the art of trademark.

Regarding claim 51, although not clearly stated by the prior art references, one skilled in the art would easily recognize that communication taken place over the networks can be for marketing, business transaction or customer service as appropriate to meet the specific needs of the users. Thus, it would have been obvious to one skilled in the art at the time the invention was made to recognize that communication taken place over the network of Megiddo in view of Rodriguez can be for marketing, business transaction or customer service as appropriate to meet the specific needs of the users.

Regarding claim 52, Megiddo teaches a method of communicating between users (col 1, lines 57-67) comprising displaying an image to a first user to represent a second user communicating with the first user by a computer and transferring a message between said first user and said second user (col 5, line 29 to col 6, line 40) (see Fig. 2a-c). However, Megiddo does not explicitly teach that there is a plurality of images owned by an organization and used under contract with said organization. However, owning images and licensing the use of the image is old and well known in the art as evidenced by Rodriguez (col 60, lines 14-23). Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Rodriguez's teaching of licensing an image for use in the system of Megiddo's system with the motivation being to bring financial reward or compensation for the organization for the use of its images.

Regarding claims 53-55, 58, 65-67 and 70, although Megiddo does not mention the commercialization of the image and chatting, it would have been obvious to one skilled in the art at the time the invention was made to use such image and chatting method and apparatus for the purpose of selling a product with the motivation being to make a profit.

Regarding claims 56 and 68, although Megiddo does not mention the security issue of the network, it would have been obvious to one skilled in the art at the time the invention was made to use such password implementation in the system of Megiddo in view of Rodriguez with the motivation being to enhance the security and integrity of the system.

Regarding claim 57, Disney's princess dolls are popular and well known around the world.

Regarding claim 61, it would have been apparent to one skilled in the art to recognize that a background with a common theme with the image would enhance the display in terms of coherency. Thus, it would have been obvious to one skilled in the art at the time the invention was made to have the background with a common theme with the image with the motivation being to enhance the coherency of the visual display.

Regarding claim 62, it would have been apparent to one skilled in the art to recognize that instructions for the computer to perform the displaying and transferring of message/image can be downloaded from a distant computer into the memory for execution. The downloading requires a signal encoded in a carrier medium to contain those instructions. Thus, it would have been obvious to one skilled in the art at the time the invention was made to download instructions for the computer to perform the displaying and transferring of message/image from a distant computer into the memory for execution with the motivation being to offer convenient software installation/ Upgrades without the use of physical disks.

Regarding claim 64, Megiddo teaches a method of communicating between users (col 1, lines 57-67) comprising displaying an image to a first user to represent a second user communicating with the first user by a computer and transferring a message between said first user and said second user (col 5, line 29 to col 6, line 40) (see Fig. 2a-c). However, Megiddo does not explicitly teach that there is a plurality of images owned by an organization and used under contract with said organization.

However, owning images and licensing the use of the image is old and well known in the art as evidenced by Rodriguez (col 60, lines 14-23). Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Rodriguez's teaching of licensing an image for use in the system of Megiddo's system with the motivation being to bring financial reward or compensation for the organization for the use of its images. Although neither Megiddo nor Rodriguez teaches that the images are characters that have a common theme, examiner takes official notice that it is well known that Disney have a plurality of characters and some of them have common themes such as princess characters, etc. Since Disney's character is so well known and popular, it would have been obvious to one skilled in the art at the time the invention was made to license Disney's characters for use with the motivation being to bring attract attentions of those who likes Disney's characters.

Regarding claim 69, Disney's princess dolls are popular and well known around the world.

6. Claims 21- 26, 29, 42-43, 59-60, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Megiddo, Rodriguez, and Liles (5880731).

Regarding claims 21, 42-43 and 59-60, although Megiddo does not clearly teach a list of image characters that can be chosen to represent the users, such feature is taught by Liles. Specifically, Liles shows in figure 3 the list of image characters that user can select to represent him or herself in the chat room. Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Liles' teaching of showing the list of image characters that user can select to represent

himself or herself in the system of Megiddo in view of Rodriguez with the motivation being to provide convenience to the user in selecting a desired character to represent himself or herself in the chat room.

Regarding claim 43, although Megiddo does not mention the commercialization of the image and chatting, it would have been obvious to one skilled in the art at the time the invention was made to use such message and chatting method and apparatus for the purpose of purchasing or selling a product with the motivation being to make a profit.

Regarding claims 22-26, although Megiddo does not clearly teach the display of expressed emotion and interaction in the image, such feature is taught by Liles. Specifically, Liles shows in figures 4-8 the difference way to express visually the emotion and interaction of the user in the chat room. Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Liles' teaching of expressing visually the emotion and interaction of the user in the system of Megiddo in view of Rodriguez with the motivation being to enhance the chatting experience for the participants.

Regarding claim 29, although Megiddo does not clearly teach the morphed version of the image, such feature is taught by Liles. Specifically, Liles shows in figure 5 the sequence of morphed images to show the movement of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply Liles' teaching of morphed version of the image in the system of Megiddo in view of

Rodriguez with the motivation being to enhance the visual side of the chatting experience for the participants.

7. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach the remote commuting with images which relates to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232). The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-872-9306

and / or:

(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

01/11/04

JOHN CABECA
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